Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/549,816	ASASHIMA ET AL.	
	Examiner	Art Unit	
	KADE ARIANI	1651	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Leon B Lankford/
Primary Examiner, Art Unit 1651

Attachment to the Advisory Action:

Applicant's arguments filed on 07/28/2008 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Drysdale et al. Applicant argues that, Drysdale et al. do not teach a method of forming autonomically beating cardiac muscle-like cell aggregates from stem cells, and teach an embryo that is not treated with RA (retinoic acid) will give rise to cardiac tissue, while treatment of an embryo with RA will induce dysfunction of cardiac tissue due to possible suppression of a differentiating factor by RA.

However, Drysdale et al. disclose in RA-treated mouse embryos a beating heart forms (p.213 1st column 2nd paragraph lines 10-13). Drysdale et al. therefore clearly anticipate the claimed method.

Applicant further argues that Drysdale et al. do not teach pluripotent stem cell capable of generating a number of different cell types, and do not culture stem cells.

However, according to the specification page 6 last paragraph, especially lines 5 and 7, stem cells such as embryonic stem cells and embryoid bodies can be used, and as mentioned before and immediately above, Drysdale et al. disclose culturing cells removed from embryo (explants) and embryos. Therefore, Drysdale et al. disclose culturing stem cells.

With respect to the rejection of claims 1-3 under 35 U.S.C. 103(a) over Drysdale et al. in view of Takahashi et al. Applicant argues that there is no reason to modify or combine the teachings of Drysdale et al. with Takahashi et al. to arrive at the presently claimed invention.

As mentioned immediately above, Drysdale et al. teach a method of forming autonomically beating cardiac muscle-like cell aggregates from stem cells, culturing stem cells derived from a vertebrate animal in the presence of retinoic acid or RA (RXR agonist). Drysdale et al. also teach heart development and myocardial differentiation are sensitive to RA signaling (Abstract and p.206 1st column 2nd and 3rd paragraphs). Drysdale et al. further teach RA can block myocardial differentiation in a stage-specific manner (p.211 1st column 3rd paragraph), depend on the effective dose of RA (p. 212 2nd column end paragraph lines 13-14 continued to p.213 1st column line 1). Drysdale et al. teach if RA treatment initiated after myocardial differentiation has commenced there is no discernible effect on the subsequent heart development (p.206 1st column 3rd paragraph 6-9).

Drysdale et al. do not teach RXR agonist is PA024 or 2-[N-cyclopropyl-methyl-N-(5, 6, 7, 8-tetrahydro-5, 5, 8, 8-tetramethynaphtahlene-2-yl)amino]pyrimidin-5-carboxylic acid). However, Takahashi et al. teach RXR agonist, PA024, and stem cell differentiation inducing activity of PA024 and selective antagonism at RXR site (Abstract. p.3328 Chart 1., p.3329 1st column 2nd paragraph, lines 10-17).

Therefore, a person of ordinary skill in the art at the time the invention was made, knowing the stem cell differentiation inducing activity and selective antagonism of PA024 at RXR site, would have been motivated to substitute the retinoic acid X receptor (RXR) ligand in the method as taught by Drysdale et al. with RXR agonist according to the teachings of Takahashi et al. to provide a method for forming autonomically beating cardiac muscle-like cell aggregation form stem cells derived from a vertebrate animal in vitro with predictable results of inducing the differentiation of stem cells, because substitution of one known RXR agonist with another known RXR agonist would have given predictable results to a person of ordinary skill in the art at the time the invention was made.

With respect to the rejection of claim 7 under 35 U.S.C. 102(b) as being anticipated by Moriya et al. Applicant argues that the embryonic ectoderm disclosed in Moriya et al. is different from the claimed embryonic stem cells and are not stem cells.

However, applicant fails to show how, because specification page 6 last paragraph especially lines 5 and 7, disclose stem cells such as embryonic stem cells and embryoid bodies can be used. As mentioned in the Final Office action, Medical dictionary online (11 March 2008) defines ectoderm, the outer layer of the three germ layers of the embryo. Therefore, Moriya disclosure of isolated ectoderm region meets the claimed stem cells derived from a vertebrate animal.

With respect to the rejection of claims 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over Moriya et al. in view of Takahashi et al. Applicant argues that there is no reason to modify or combine the teachings of Moriya et al. and Takahashi et al. to arrive at the presently claimed invention.

However, Moriya et al. teach the isolated ectoderm region differentiated into pancreas when cultured in the presence of retinoic acid receptor (RAR ligand) (Abstract).

Moriya et al. do not teach the retinoic acid receptor (RAR) ligand is 4-[(5, 6, 7, 8,-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl] benzoic acid. However, Takahashi et al. teach retinoic acid receptor (RAR) ligand (agonist) Am80 (or 4-[(5, 6, 7, 8,-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl] benzoic acid) (Abstract). Takahashi et al. teach a combination of Am80 with an RXR ligand (agonist) induce differentiation of stem cells (p.3328 2nd column end paragraph). Takahashi et al. further teach the clinical potential of compounds (RXR antagonists) that inhibit the activation of retinoic acid receptors (RARs) induced by RAR agonists, as antidiabetic and antiobesity agents (p.3327 2nd column 1st paragraph lines 8-15).

Therefore, a person of ordinary skill in the art at the time the invention was made, knowing that a combination of retinoic acid receptor (RAR) ligand and a RXR ligand induce differentiation of stem cells, would have been motivated to apply the prior art teachings an to use the retinoic acid receptor (RAR) ligand as taught by Takahashi et al. in the method of Moriya et al. to provide a method for forming a tissue having morphology and function of pancreas from stem cells derived from a vertebrate animal with a reasonable expectation of success.